REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 5, 2005. Claims 21-44, 46-52, 54-57 and 59-62 were pending in the Application. In the Office Action, Claims 40-44, 46, 47, 49-51, 54, 55, 59, 61 and 62 were rejected, and Claims 21-39 were allowed. In order to expedite prosecution of this Application, Applicant amends Claims 40, 47, 55 and 59. Thus, Claims 21-44, 46-52, 54-57 and 59-62 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

DOUBLE PATENTING

Claims 40 and 41 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14 of U.S. Patent No. 6,721,260 (the "'260 Patent"). Applicant respectfully traverses this rejection. Of the rejected claims of the present Application, Claim 40 is independent. Of the claims of the '260 Patent referred to by the Examiner, Claims 1 and 14 are independent. Independent Claim 1 of the '260 Patent recites "and optical signal generator" and "an electromagnetic element" where "the electromagnetic element comprises at least a multi-layer printed circuit board with conductive traces formed on at least one layer of the printed circuit board." Independent Claim 14 of the '260 Patent recites "an optical signal generator" and "an electromagnetic element" where "the electromagnetic element comprises a plurality of conductive traces formed on a printed circuit board configured to generate the electromagnetic field." In contrast, pending independent Claim 40 of the present Application does not include at least the noted limitations. Nor do the claims of the '260 Patent disclose, teach or suggest the limitations as recited by Claim 40 of the present Application (e.g., at least "means responsive to an electromagnetic field for tracking control in a first direction and sweep control in a second direction different than the first direction" as recited by Claim 40). Applicant respectfully submits that Claim 40, and Claim 41 that depends therefrom, are patentably distinct from the claims of the '260 Patent and, therefore, Applicant respectfully requests that this rejection be withdrawn.

ALLOWED CLAIMS

Applicant thanks the Examiner for indicating the allowance of Claims 21-39. Claims 21-39 remain unchanged. Therefore, Applicant respectfully submits that Claims 21-39 remain in condition for allowance.

SECTION 102 REJECTIONS

Claims 40, 41 and 43 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,768,037 issued to Marino et al. (hereinafter "*Marino*"). Additionally, Claims 46, 47, 49, 55 and 59 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application No. 5,218,587 issued to Nomiyama et al. (hereinafter "*Nomiyama*"). Applicant respectfully traverses these rejections.

Claims 40, 41 and 43

Of the rejected Claims 40, 41 and 43, Claim 40 is independent. Applicant respectfully submits that *Marino* does not disclose or even suggest each and every limitation of independent Claim 40. For example, Applicant respectfully submits that *Marino* does not appear to disclose or even suggest a "means for reflecting an optical signal toward the data storage medium, the reflecting means responsive to an electromagnetic field for tracking control in a first direction and sweep control in a second direction different than the first direction" and "at least one conductive coil means formed on a printed circuit board for generating the electromagnetic field" as recited by Claim 40 (emphasis added). *Marino* appears to disclose a lens holder 11 suspended by four flexures 5a-5d where the lens holder is movable in response to a magnetic force (*Marino*, column 3, lines 5-36, figures 1 and 2). However, *Marino* appears to disclose that the lens holder is movable in response to the magnetic force only in either a focus or tracking direction (e.g., "The wires [flexures 5a-5d] bend in response to forces applied to the lens holder 11 permitting the lens holder 11 to translate in the focus and tracking directions" (*Marino*, column 3, lines 35-37)). Thus, *Marino* does not appear to disclose or even suggest "means for reflecting an optical signal toward the data storage medium, the reflecting means responsive to an electromagnetic field for tracking control in a first direction and sweep control in a second direction different than

the first direction" as recited by independent Claim 40. Accordingly, for at least this reason, Applicant respectfully submits that Claim 40 is patentable over the *Marino* reference.

Claims 41 and 43 that depends from Claim 40 are also not anticipated by *Marino* at least because they incorporate the limitations of Claim 40 and, also, they add additional elements that further distinguish *Marino*. Therefore, Applicant respectfully requests that the rejection of Claims 41 and 43 be withdrawn.

Claims 46, 47, 49, 55 and 59

Of the rejected Claims 46, 47, 49, 55 and 59, Claims 47, 55 and 59 are independent. Applicant respectfully submits that *Nomiyama* does not disclose or even suggest each and every limitation of independent Claims 47, 55 and 59. For example, Applicant respectfully submits that *Nomiyama* does not appear to disclose or even suggest "a reflector element movable relative to the electromagnetic element in response to the electromagnetic field" where "the reflector element [is] responsive to the electromagnetic field for sweep control in a first direction and tracking control in a second direction different than the first direction relative to the electromagnetic element" as recited by Claim 47 (emphasis added). *Nomiyama* appears to disclose a carriage member (s) movable along a rail 9 in response to a magnetic field generated by a coil 5 disposed along the rail 9 of *Nomiyama* for "seek adjust purposes" (*Nomiyama*, column 10, lines 14-66, figure 7). *Nomiyama* also appears to disclose a movable focus adjusting member (p) coupled to a plate spring (t) to enable focus adjusting of adjusting member (p) (e.g., in the vertical direction) in response to an electromagnetic field generated by focus coil 4 of *Nomiyama* (*Nomiyama*, column 10, lines 14-668, column 11, lines 26, figure 7). Thus, *Nomiyama* appears to only provide either seek adjustment or focus adjustment based on an electromagnetic field, in contrast to "a reflector element movable relative to the electromagnetic element in response to the electromagnetic field" where "the reflector element [is] responsive to the electromagnetic field for sweep control in a first direction and tracking control in a second direction different than the first direction relative to the electromagnetic element" as recited by Claim 47 (emphasis added). Accordingly, for at least this reason, Applicant respectfully submits hat independent Claim 47 is patentable over the *Nomiyama* reference.

Independent Claim 55 recites "means for generating an electromagnetic field" and "means for directing an optical signal toward the data storage medium, the directing means movable for sweep control in a first direction and tracking control in a second direction different than the first direction relative to the generating means in response to the electromagnetic field" (emphasis added), and independent Claim 59 recites "generating an electromagnetic field proximate to a reflector element using an electromagnetic element" and "controlling, via the electromagnetic field, sweep movement of the reflector element in a first direction and tracking movement of the reflector element in a second direction different than the first direction relative to the electromagnetic element" (emphasis added). Applicant respectfully submits that at least for the reasons discussed above in connection with independent Claim 47, independent Claims 55 and 59 are also patentable over the *Nomiyama* reference.

Claims 46 and 49 that depends from Claim 47 are also not anticipated by *Nomiyama* at least because they incorporate the limitations of Claim 47 and, also, they add additional elements that further distinguish *Nomiyama*. Therefore, Applicant respectfully requests that the rejection of Claims 46 and 49 be withdrawn.

SECTION 103 REJECTIONS

Claims 40-44, 50, 51, 54, 61 and 62 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Nomiyama* in view of *Marino*. Applicant respectfully traverses this rejection.

Claims 50, 51, 54, 61 and 62 depend respectively from independent Claims 47, 55 and 59. As discussed above, independent Claims 47, 55 and 59 are in condition for allowance. Therefore, Claims 50, 51, 54, 61 and 62 that depend respectively therefrom are also in condition for allowance and, accordingly, Applicants respectfully requests that the rejection of Claims 50, 51, 54, 61 and 62 be withdrawn.

Of the remaining rejected claims, Claim 40 is independent. Independent Claim 40 recites, at least in part, "means for reflecting an optical signal toward the data storage medium, the reflecting means responsive to an electromagnetic field for tracking control in a first direction and sweep control in a second direction different than the first direction" and "at least one conductive coil means formed on a printed circuit board for generating the electromagnetic field" (emphasis added). As discussed above, Applicant respectfully submits that neither *Marino* nor *Nomiyama*, alone or in combination, discloses, teaches or suggests a reflecting means responsive to an electromagnetic field for tracking control and sweep control in two different directions as generally recited by independent Claim 40. Accordingly, Applicant respectfully requests that the rejection of Claim 40, and the rejection of Claims 41-44 that depend therefrom, be withdrawn.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicant has overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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